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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,248	05/18/2005	Yoji Ito	019519-477	5782
21839 7590 09/04/2007 BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			EXAMINER SESE, JASON A	
			ART UNIT 1709	PAPER NUMBER
			MAIL DATE 09/04/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<p align="center"><b>Office Action Summary</b></p>	<p><b>Application No.</b></p> <p>10/535,248</p>	<p><b>Applicant(s)</b></p> <p>ITO ET AL.</p>	
	<p><b>Examiner</b></p> <p>Jason A. Sese</p>	<p><b>Art Unit</b></p> <p>1709</p>	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 May 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application  |
| Paper No(s)/Mail Date <u>03 August 2006; 18 May 2005</u>                               | 6) <input type="checkbox"/> Other: _____                           |

## DETAILED ACTION

### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

**Group I, claim(s) 1-5**, drawn to a method for producing an optical compensating sheet, comprising a step of simultaneously coating at least two coating solutions on a transparent support, wherein at least one of the coating solutions simultaneously coated in said step contains a liquid crystalline compound, and another coating solution of the coating solutions contains a surface active agent.

**Group II, claim(s) 6-20**, drawn to an optical film comprising a support having thereon an optically anisotropic layer comprising a liquid crystalline compound, wherein said optically anisotropic layer comprises a fluoroaliphatic group-containing copolymer containing a repeating unit derived from the following monomer (i) and a repeating unit derived from the following monomer (ii).

2. The inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The common technical feature of Groups I-II is an optical compensation film comprising a support having an optically anisotropic layer comprising a fluorine containing surface active agent.

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However, Masataka et al. (JP 2001-330725 A) teach an optical compensation sheet having an optically anisotropic layer consisting of liquid crystalline molecules and a fluorine substituted group. The common technical feature is non-novel, and as there exists no other common link to form a single inventive concept, inventions must be restricted due to a lack of unity..

3. During a telephone conversation with Mr. Roger Lee on 22 August 2007, a provisional election was made with traverse to prosecute the invention of Group II, Claims 6-20. Affirmation of this election must be made by applicant in replying to this Office Action. Claims 1-5 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Priority***

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 6-11, 13-14 and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Negoro et al. (EP 1 079 244 A2).**

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7. **Regarding Claim 6**, the applicant claims an optical compensating sheet that consists of a transparent support having at least two coating solutions, the first coating solution containing a liquid crystalline compound, and the second coating solution containing a surface active agent.

Negoro et al. disclose an optical compensatory sheet comprising a transparent support with a liquid crystal layer further containing a copolymer in which a surface active agent is present (fluorine substituted hydrocarbon group), thereby anticipating the applicant's claim [0018].

8. **Regarding Claims 10-11 and 13-14**, Negoro et al. disclose:

An optical compensatory sheet arranged adjacent to a polarizer, thereby creating the polarizing plate of Claim 10 [0019].

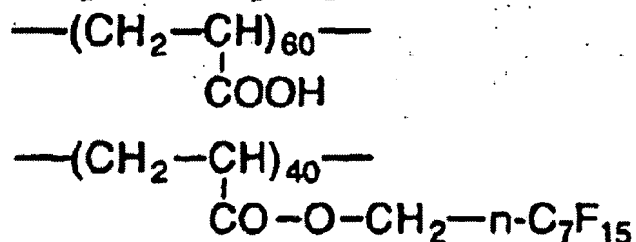
A liquid crystal display that comprises a liquid crystal cell and two polarizing elements arranged on both sides of the liquid crystal cell, where at least one of the polarizing elements is to an optical compensation sheet, thereby anticipating Claims 11 and 13 [0019].

A liquid crystal display described above wherein the liquid crystal cell is vertically aligned [0012] or Super TN-mode [0019], anticipating Claim 14, which claims a TN-mode cell or a vertical-alignment cell.

9. **Regarding Claim 7**, the applicant claims an optical film that comprises an optically anisotropic layer further comprising a copolymer containing a fluoroaliphatic monomer and an acrylic monomer.

Negoro et al disclose in Example 13 (shown below), a copolymer containing (1) a fluoroaliphatic group-containing monomer and (2) a poly(oxyalkylene) acrylate that anticipate that applicant's claim.

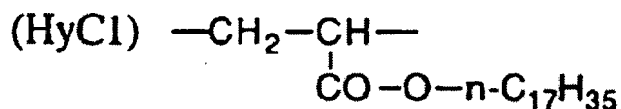
Acrylic copolymer (PA201)



Negoro et al. - Example 13

10. **Regarding Claim 8**, in addition to the composition claimed in Claim 7, the applicant claims an additional composition further comprising a third monomer.

Negoro et al. state that two or more (meth)acrylic copolymers can be used in combination [0175], and provide a monomer unit that matches the additional monomer structure claimed by the applicant (shown below). Combining the copolymer from Claim 7, and including the monomer unit below anticipates the applicant's claim.



Example of Formula (II) – HyC1, Negoro, page 9

11. **Regarding Claim 9**, the applicant claims an optical film wherein the liquid crystalline compound is a discotic compound. Negoro et al. anticipate this claim by disclosing that the liquid crystal molecules in the optical anisotropic layer are discotic molecules [0019].

12. **Regarding Claims 17-20**, see above remarks concerning Claims 10-11, 13 and 16.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. **Claims 12, 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Negoro et al. (EP 1 079 244 A2).**

15. ***Regarding Claim 12***, the applicant claims a polarizing plate comprising a polarizing film and protective film on both side of the polarizing film, wherein one of the protective films is an optical compensating sheet claimed in Claim 6.

Negoro et al. disclose a polarizing plate that comprises a polarizing film, and an optical compensating sheet disposed on one side of said polarizing film, but is silent to a protective sheet disposed on the opposite side of the polarizing film [0019].

It was well known in the art at the time of invention to provide a protection film on the surface of optical components so it would have been obvious to one ordinary skill to provide a protection film on the surface of a polarizing film.

16. ***Regarding Claim 15***, Negoro et al. disclose a liquid crystal display that comprises a liquid crystal cell and two polarizing elements arranged on both sides of the liquid crystal cell, where at least one of the polarizing elements is to an optical compensation sheet [0019]. It would have been obvious to one of ordinary skill in the art to use the polarizing plate of Claim 12 in the liquid crystal display of Claim 15.

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17. **Regarding Claim 16**, Negoro et al. disclose a liquid crystal display described in Claim 15, wherein the liquid crystal cell is vertically aligned [0012] or Super TN-mode [0019]. Hence, it would have been obvious to one of ordinary skill in the art to use a TN or vertically aligned cell in the liquid crystal display of Claim 15.

### **Conclusion**

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fujita et al. (U.S. Patent No. 7,105,270), Negoro et al. (U.S. Patent No. 7,052,745), and Onishi et al. (U.S. Patent No. 5,624,974).

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason A. Sese whose telephone number is 571-270-3473. The examiner can normally be reached on Mon-Thurs, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, D. Lawrence Tarazano can be reached on 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**D. LAWRENCE TARAZANO**  
**PRIMARY EXAMINER**



Jason A. Sese  
Examiner  
Art Unit 1709

